

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*Sand CPH A/S*

*v.*

*Xiuling Guo*

—  
Opposition No. 91237844

Miriam D. Trudell and Caroline E. Bryce of Sheridan Ross P.C.  
for Sand CPH A/S.

Lawrence J. Crain of Greer, Burns & Crain, Ltd.  
for Xiuling Guo.

—  
Before Kuhlke, Shaw and Heasley,  
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Xiuling Guo, seeks registration of the mark



for “Clothing apparel, namely, scarves, mufflers, dresses, skirts, sweaters, coats, ponchos, jumpers, gloves, caps, blouses,” in International Class 25.<sup>1</sup>

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<sup>1</sup> Serial No. 87370054, filed March 14, 2017, based on an allegation of first use in August 2015 and first use in commerce on August 5, 2016 under Section 1(a) of the Trademark Act,

Opposer, Sand CPH A/S, has opposed registration of Applicant's mark on the ground that, as used in connection with Applicant's goods, the mark so resembles Opposer's previously used and registered standard character mark SAND, for a variety of goods and services including clothing in International Class 25 and retail services, featuring, inter alia, clothing in International Class 35, as to be likely to cause confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Not. of Opp., 1 TTABVUE. By its answer, Applicant admits that "the USPTO records reflect the alleged averments of paragraph 2" regarding Opposer's pleaded registration, the allegations regarding Applicant's application, and that "some of the Class 25 goods covered in U.S. Application Serial No. 87380054 are highly related to, if not identical to, the Class 25 goods covered in U.S. Registration No. 3046413 and are highly similar to, if not identical to, the clothing goods sold in the retail store services covered in Class 35 in U.S. Registration No. 3046413." Ans. ¶¶ 2, 3, 4, 10, 8 TTABVUE 4, 6, and denies the remaining salient allegations.<sup>2</sup>

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15 U.S.C. § 1051(a). The application includes the following description of the mark: The mark consists of the term "SANDRIVER" with a design of a sheep. Color is not claimed as a feature of the mark.

<sup>2</sup> Applicant's "affirmative defenses" are for the most part amplifications of its denials. Applicant did not pursue the insufficiently pleaded laches affirmative defense at trial, so it is deemed waived. *See, e.g., Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013) (respondent's affirmative defense of failure to state a claim not argued in brief deemed waived), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Miller v. Miller*, 105 USPQ2d 1615, 1616 n.3 (TTAB 2013) (affirmative defense of unclean hands deemed waived because applicant failed to argue and present evidence regarding the defense at trial). Moreover, in general laches is not a proper defense against an opposition. *Nat'l Cable Television Ass'n Inc. v. Am. Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991).

## I. RECORD

The record includes the pleadings and, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), the file of the application subject to the notice of opposition. Opposer submitted notices of reliance on: (1) USPTO Trademark Status & Document Retrieval system (TSDR) printout of its pleaded Registration No. 3046413, which shows that the registration is subsisting and owned by Opposer;<sup>3</sup> (2) Applicant's discovery responses;<sup>4</sup> (3) excerpts from the printed publications Levy's and John Craig;<sup>5</sup> printouts from Opposer's website and third-party retailer websites;<sup>6</sup> and printouts of articles from online publications.<sup>7</sup>

Applicant submitted her testimony declaration ("Guo Decl.") with accompanying exhibits.<sup>8</sup> In addition, Applicant submitted a notice of reliance on: (1) dictionary definition for the word SAND;<sup>9</sup> (2) TSDR printouts of twenty third-party use-based registrations for marks that include the word SAND for a variety of clothing items;<sup>10</sup> (3) printouts of thirteen third-party web pages showing SAND as part of a brand name for a variety of clothing items;<sup>11</sup> (4) printouts of five third-party websites

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<sup>3</sup> 21 TTABVUE 5-16. Pleadings may be made of record by submitting "a current copy of information from the electronic database records of the Office showing the current status and title of the registration." Trademark Rule 2.122(d), 37 C.F.R. § 2.122(d).

<sup>4</sup> 21 TTABVUE 17-60.

<sup>5</sup> 21 TTABVUE 62-196; 22 TTABVUE 5-156.

<sup>6</sup> 23 TTABVUE 8-340.

<sup>7</sup> 23 TTABVUE 342-50.

<sup>8</sup> 24 TTABVUE 231.


<sup>9</sup> 24 TTABVUE 3-6.

<sup>10</sup> 24 TTABVUE 7-89.

<sup>11</sup> 24 TTABVUE 91-143.

showing use of the word SAND to refer descriptively to a color tone for clothing items;<sup>12</sup> (5) TSDR printout of Opposer’s registration showing it is not incontestable;<sup>13</sup> (6) printouts of Applicant’s web pages showing use of Applicant’s mark;<sup>14</sup> (7) copy of a study entitled “Sand River – Breaking Into the Luxury Cashmere Market”;<sup>15</sup> and (8) copy of a decision from the European Intellectual Property Office (EUIPO) denying invalidation for Applicant’s registration.<sup>16</sup>

## II. SECTION 2(d) CLAIM

Section 2(d) of the Trademark Act prohibits the registration of a mark that “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d). To prevail on its Section 2(d) claim, Opposer must prove, by a preponderance of the evidence, that it has priority with respect to its asserted SAND mark vis-à-vis Applicant’s mark  sandriver, and that Applicant’s use of its mark in connection with the goods identified in its application is likely to

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<sup>12</sup> 24 TTABVUE 147-64.

<sup>13</sup> 24 TTABVUE 166-68.

<sup>14</sup> 24 TTABVUE 170-77.

<sup>15</sup> 24 TTABVUE 179-216. Applicant characterized this as a printed publication. This type of material is not considered a printed publication in general circulation appropriate for submission under notice of reliance. However, it was also properly introduced under Applicant’s testimony declaration. Guo Decl. ¶ 11, Exh. 4, 24 TTABVUE 233, 286.

<sup>16</sup> 24 TTABVUE 333-43.

cause confusion, mistake, or deception as to the source or sponsorship of those services. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000).

A. Standing and Priority

Opposer's pleaded and proven registration is summarized below:

Registration No. 3046413 for the standard character mark SAND for "Footwear and headwear; men's, women's clothing, namely, beachwear and coverups; clothing belts; blazers; blouses; coats; culottes; peddle-pushers; dresses; gowns; dressing and night gowns; gloves; jackets; jeans; jerseys; jumpers; jumpsuits; leggings; mittens; overalls; overcoats; pants; pantsuits; pullovers; robes; scarves; shawls; suits; skirts; shorts; slacks; sleepwear; trousers; smocks; tuxedos; stockings; suit coats; suspenders; sweat suits, pants, shorts and shirts; sweaters; vests; shirts; t-shirts; tank tops; ties; tights; topcoats; tops; underclothes; undergarments; underwear; camisoles; undershirts, chemise; underpants; slippers; socks; neckties; neckerchiefs; bandanas; mufflers," in International Class 25 and "Retail store services, featuring footwear and headwear; men's, women's clothing, namely, beachwear and cover-ups; clothing belts; blazers; blouses; capes; coats; culottes; peddle-pushers; dresses; gowns; dressing and night gowns; gloves; jackets; jeans; jerseys; jumpers; jumpsuits; leggings; mittens; overalls; overcoats; pants; pantsuits; pullovers; robes; scarves; shawls; suits; skirts; shorts; slacks; sleepwear; trousers; smocks; tuxedos; stockings; suit coats; suspenders; sweat suits, pants, shorts and shirts; sweaters; vests; shirts; t-shirts; tank tops; ties; tights; topcoats; tops; underclothes; undergarments; underwear; camisoles; undershirts, chemise; underpants; slippers; socks; neckties; neckerchiefs; bandanas; mufflers," in International Class 35, filed on July 16, 2004, issued on January 17, 2006, Section 71 affidavit accepted on February 1, 2016.

Because Opposer has made its pleaded registration properly of record, Opposer has established its standing to oppose registration of Applicant's mark and its priority is

not in issue with respect to the marks and goods and services in the registration. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); and *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Applicant does not dispute Opposer's standing or priority. App. Brief, 27 TTABVUE 7.

B. Likelihood of Confusion

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019) (Board considers each *DuPont* relevant factor for which there is evidence and argument). Two key considerations are the similarities between the marks and the similarities between the goods and services. *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *see also In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) ("The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but 'may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods'" (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1340, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002))).

1. Relatedness of the Goods and Services, Channels of Trade, Classes of Purchasers, and Conditions of Sale

We turn first to a consideration of the goods, channels of trade, classes of purchasers and conditions of sale. We must make our determinations under these factors based on the goods as they are recited in the registration and application. *See Octocom Sys. Inc. v. Houston Comput. Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.”); *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

The subject application and Opposer’s registration contain identical goods (scarves, mufflers, dresses, skirts, sweaters, coats, jumpers, gloves, blouses) and legally identical goods (Opposer’s “headwear” encompasses Applicant’s “caps”). We also find Applicant’s “ponchos” related to Opposer’s various clothing items of outerwear. It is sufficient for a finding of likelihood of confusion if relatedness is established for any item encompassed by the identification of goods or services within a particular class in the application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014).

Because the goods are identical and legally identical and there are no limitations as to channels of trade or classes of purchasers in either the application or Opposer’s registration, we must presume that Applicant’s and Opposer’s goods will be sold in

the same channels of trade and will be bought by the same classes of purchasers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (TTAB 2012); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

The same is true as to the conditions of sale and whether the goods are subject to more careful purchasing decisions. Because there are no limitations as to type of clothing, Opposer's and Applicant's arguments pertaining to high end or luxury clothing items based on extrinsic evidence are unavailing. The nature and scope of a party's goods or services must be determined on the basis of the goods or services recited in the application or registration. *See, e.g., Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (Board must "give full sweep" to an identification of goods regardless of registrant's actual business). We must consider clothing items from all price points and styles, and base our determination on the least sophisticated consumer of the identified goods. *Stone Lion*, 110 USPQ2d at 1163 (cited in *In re FCA US LLC*, 126 USPQ2d 1214, 1222 (TTAB 2018) ("Board precedent requires our decision to be based on the least sophisticated potential purchasers.")). Because Applicant's identification of goods is unrestricted and because the clothing items in Opposer's registration are also unrestricted, we must assume that these goods are sold to ordinary purchasers who exercise no more than ordinary care in their purchasing decisions. *See In re Fabfitfun, Inc.*, 127 USPQ2d 1670, 1673 (TTAB 2018) (no restriction of price in identifications



required Board to consider degree of care exercised by purchasers of low-cost cosmetics). Moreover, even though some consumers may take more care in their clothing purchases, as noted above, the standard of care for purchasing the goods is that of the least sophisticated purchaser. *Alfacell Corp. v. Anticancer, Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004).

In view of the above, the similarity of the goods, the channels of trade, classes of purchasers and conditions of sale favor a finding of likelihood of confusion.

## 2. Strength of the SAND mark

Before we compare the marks, we address the strength of Opposer's mark. A mark's strength is measured both by its conceptual, or inherent, strength and its commercial, or marketplace, strength. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010); *see also Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017) ("In determining strength of a mark, we consider both inherent strength, based on the nature of the mark itself, and commercial strength or recognition.").

In the likelihood of confusion context, fame or commercial strength "varies along a spectrum from very strong to very weak." *Joseph Phelps Vineyards, LLC v. Fairmount Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017). A famous mark is one that has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002). Fame, if it exists, plays a dominant role in the likelihood of confusion analysis. *Kenner Parker Toys Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). In view of the extreme deference that is accorded a famous mark in terms

of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to prove it clearly.

The commercial strength of a mark “may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods or services traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.” *Bose Corp. v. QSC Audio Prods., Inc.*, 63 USPQ2d at 1305. Conversely, commercial weakness as shown by “the number and nature of similar marks in use on similar goods” serves to show that “customers have been educated to distinguish between different such marks on the bases of minute distinctions.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

Opposer argues that it has used the SAND mark “internationally for over 30 years” and that “Opposer is widely recognized as a leader in the fashion industry and its SAND Mark is famous.” Opp. Brief, 25 TTABVUE 22. In support of this assertion, Opposer submitted excerpts of advertisements in two magazines (Levy’s and John Craig);<sup>17</sup> excerpts of third-party websites showing the SAND brand displayed; examples of unsolicited media coverage from Flaunt magazine;<sup>18</sup> references to SAND clothing in connection with clothing worn by celebrities;<sup>19</sup> and excerpts from its

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<sup>17</sup> 21 TTABVUE 84-85, 123, 132; 22 TTABVUE 11, 96, 113, 128-31.

<sup>18</sup> 23 TTABVUE 342-50.

<sup>19</sup> 23 TTABVUE 342-50.

website listing various fashion shows.<sup>20</sup> Opposer concludes that its decades of longstanding and continuous use and the evidence of the general public's association of the name with Opposer and recognition of the SAND mark supports a finding that it is famous.

Opposer offered no testimony to establish its length of use, geographic scope, amount of sales, or advertising expenditures.<sup>21</sup> To establish the length and geographic extent of use Opposer relies on excerpts from its website. These excerpts, while admissible for what they show on their face, have little probative value on these points because the content is hearsay and may not be taken for truth of the matter asserted. The significance and probative value of the magazine excerpts is not clear. There is no testimony as to how many views there are of the references or the circulation for the magazines. There are excerpts from fashion magazines for 2014, 2016 and 2018, but there is nothing in the record to establish how frequently or for how long the advertisements have run. The celebrity mentions shown on websites that include the URL and date of run from 2014-2019 point to more prominent exposure, but the record here is very sparse. In sum, Opposer has failed to show that its SAND mark is so commercially strong for clothing that we should accord it a broader scope of protection.

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<sup>20</sup> 23 TTABVUE 15-16.

<sup>21</sup> The declarations of use filed in the underlying applications for the pleaded registrations are not testimony. Trademark Rule 2.122(b)(2), 37 C.F.R. § 2.122(b)(2) (“Statements made in an affidavit or declaration in the file of an application for registration, or in the file of a registration, are not testimony on behalf of the applicant or registrant.”).

On the other hand, Applicant contends that Opposer’s mark is weak in view of third-party registrations and uses in connection with clothing and clothing-related goods. App. Brief, 27 TTABVUE 13. A mark’s commercial strength may be curtailed by third-party use of similar marks with similar goods or services. *Jack Wolfskin Austrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015). Active third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so common that the public will look to other elements to distinguish the source of the goods or services. *See, e.g., In re i.am.symbolic*, 123 USPQ2d at 1751; *Jack Wolfskin*, 116 USPQ2d at 1136; *Juice Generation*, 115 USPQ2d at 1674-75.

Applicant points to several third-party registrations and examples of third-party use of marks that include the word SAND for identical clothing items.

<b>Mark</b>	<b>Registration/Goods</b>	<b>Use/Goods</b>
SAND STUFF	No. 5534535 for Caps being headwear; coats; dresses; footwear; hats; headbands; headwear; jackets; scarves; shirts; skirts; socks; sweaters; t-shirts; ties as clothing; trousers; undergarments 24 TTABVUE 8-10	www.sandstuffshirts.com T Shirts 24 TTABVUE 92
KICK SAND	No. 5331527 for Beanies; hats; jackets; shirts; sweatshirts; swim suits; tops; hooded sweatshirts; T-shirts 24 TTABVUE 12-14	www.kicksand.com tank tops, hoodies, sweatshirts, leggings 24 TTABVUE 96-101

Mark	Registration/Goods	Use/Goods
SAND CLOUD	No. 5213877 for bikinis; T-shirts 24 TTABVUE 16-18	www.sandcloud.com Shirts, hoodies, tank tops 24 TTABVUE 102-04
SOMEWHERE IN THE SAND	No. 5160322 for Beanies; Dresses; Hats; Jackets; Pants; Shorts; Socks; Swimsuits; T- shirts; Tank-tops; Hooded pullovers 24 TTABVUE 20-23	https://saltwaterhippie.com Casual clothing 24 TTABVUE 106
SAND ASSAULT	No. 5136388 for Hats; Hoodies; Shorts; T-shirts; Tank tops 24 TTABVUE 24-26	www.jerichospecialties.com Caps, t-shirts 24 TTABVUE 108-10
	No. 4732952 for clothing, namely, tops, bottoms, beachwear, swimwear, hats, headbands, headwear, jackets, jerseys, beanies 24 TTABVUE 28-31	https://sandlifeclothing.com t-shirts, tank tops, sweatshirts, hoodies, caps, pants 24 TTABVUE 112-17
LOVE SAND	No. 4570182 for hats; jackets; pants; shirts; sweat shirts; sweat shirts 24 TTABVUE 32-34	
SAND JUNKIE	No. 4050172 for clothing, namely, shirts, tank tops, pants, shorts, hats, visors, beanies, sweatshirts and hooded sweatshirts 24 TTABVUE 36-38	
SUN 'N' SAND	No. 4706081 for hats; sandals; sarongs 24 TTABVUE 40-43	www.sunnsand.net Hats, dresses 24 TTABVUE 118- 20
	No. 4556731 for apparel, namely, women's, men's and children's knit shirts, tee shirts, woven shirts, hats, caps, fleece tops, fleece pants, sweaters, sweater vests, jackets, pajamas, swim wear, footwear, including golf shoes; golf pants and golf shorts 24 TTABVUE 44-47	www.bermudasandsapparel .com Tops, skirts, dresses, 24 TTABVUE 121-23
HAUTE SAND	No. 4275101 for t-shirts 24 TTABVUE 48-51	
SAND KNIT	No. 3654019 for athletic uniforms, warm-ups, sweat suits; award and training jackets 24 TTABVUE 52-55	

<b>Mark</b>	<b>Registration/Goods</b>	<b>Use/Goods</b>
GOT SAND?	No. 2442832 for shirts, jackets, pants and hats 24 TTABVUE 56-58	
SAND STYLE	No. 3057216 for clothing, namely shirts, jackets, and hats 24 TTABVUE 60-62	
SAND & SPIRIT	No. 4719275 for clothing, inter alia, tops and bottoms for women; dress suits; dresses; jackets; coats, trousers, vests, sweatpants for women 24 TTABVUE 64-67	
SAND ONER	No. 5276240 for body suits; hats; leggings; pants; shirts; socks; sweaters; tank-tops; underwear; bottoms; hoodies; hoods; jackets; sports caps and hats; sports caps and hats; tops 24 TTABVUE 68-71	
SKY AND SAND	No. 5184429 for women's clothing, namely, shirts, dresses, skirts, blouses 24 TTABVUE 72-75	
FRIENDLY SAND	No. 2168124 for footwear and clothing, namely, shirts, hats, shorts, pants, dresses, coats, and jackets 24 TTABVUE 76-78	
SANDEVER	No. 4374090 for clothing, inter alia, shirts, pants, tank tops, pullovers, sweatshirts, trousers, shorts, jackets, coats, tee-shirts, belts, gloves, caps 24 TTABVUE 81-84	
SANDUSA	No. 5084170 for apparel, inter alia, t-shirts, jackets, pants, pajamas, sandals, shoes, sweaters, shirts, shorts, shocks, gloves, hats 24 TTABVUE 87-90	
BLUE SAND TEXTILES		<a href="http://www.thebridebox.com">www.thebridebox.com</a> Custom clothing 24 TTABVUE 125-26
SANDOVAL		<a href="http://www.bing.com/shop?q=sandoval">www.bing.com/shop?q=sandoval</a> doval t-shirts, hoodies,

Mark	Registration/Goods	Use/Goods
		jackets, sweatshirts, pullovers, 24 TTABVUE 128-32
NOBLE SANDS		www.noblesands.com Dresses 24 TTABVUE 134-36
ROCOCO SAND		www.bloomingdales.com Dresses, 24 TTABVUE 138 www.saksfifthavenue.com dresses 24 TTABVUE 141-44

In addition, Applicant submitted examples of third-party websites offering clothing items for sale using the word “sand” to describe the color of the item, as shown below:<sup>22</sup>



Twelve of the twenty examples of third-party trademark use and registration have a similar structure to Applicant’s mark with the letters forming SAND at the beginning and a second word or lettering. The remaining examples are not as probative but they add to the weight of evidence showing the third-party use of the

<sup>22</sup> <https://us.marinarinaldi.com>, <https://naadam.co> 24 TTABVUE 148-51.

word “sand” in clothing marks. This evidence demonstrates several third parties using the word SAND in their marks in connection with identical clothing items, third parties registering marks that include SAND for clothing items, and third-party retailers using the word “sand” descriptively to indicate the color of the clothing item. The examples of use in the record point to consumer exposure to both descriptive uses and dilutive uses of the word “sand.” *Juice Generation*, 115 USPQ2d at 1674 (referring to evidence of “a fair number” of third-party marks). Based on this record, the SAND mark is somewhat conceptually weak and commercially diluted when used in connection with clothing.

### 3. Similarity of the Marks

We now consider the similarity or dissimilarity of Applicant’s mark



and Opposer’s mark SAND when compared in their entireties in terms of appearance, sound, connotation and commercial impression. *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1048 (Fed. Cir. 2018). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)). “The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (quotation omitted). The marks must be considered in their entireties, but “in



articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety.” *Detroit Athletic*, 128 USPQ2d at 1051 (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985)). Finally, based on the findings above, we consider the marks within the context of the several third-party registrations and uses in the marketplace.

Opposer argues that Applicant’s mark wholly incorporates Opposer’s mark SAND, that that term is the dominant portion of both marks, and that the word portion of Applicant’s mark dominates its design element. Opp. Brief, 25 TTABVUE 19. Opposer characterizes the “RIVER” portion of Applicant’s mark as “non-distinctive” and asserts that it “does not aid to distinguish between the marks.” *Id.* Applicant points out that Opposer has presented no evidence of consumer impressions of the marks and the “unsubstantiated statements regarding the alleged impression created by the marks are insufficient to carry Opposer’s burden of proof.” App. Brief, 27 TTABVUE 12.

While both marks contain the word SAND, the similarity ends there. The word portion in Applicant’s mark SANDRIVER in this stylized form,



, has all of the letters in lower case and in about the same height. It may be viewed by apparel consumers in various ways: as one word, as SAN combined with the word DRIVER, as SAND DRIVER telescoping the letter D, or as SAND RIVER. Opposer relies on the possibility that consumers will perceive

SAND RIVER, discard the word RIVER and arrive at Opposer's mark SAND. To the extent consumers separate the letters to form the words SAND RIVER, this does not aid in finding similarity. Opposer's mark connotes simply the word "sand" or suggests a "sand" color scheme. Applicant's mark, if interpreted as "sand river," evokes a place, possibly where the goat pictured in the mark grazes.<sup>23</sup> *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998) (CRISTAL not confusingly similar to CRYSTAL CREEK both for wine (including champagne) because the "former suggested the clarity of the wine within the bottle or the glass of which the bottle itself was made, the later suggested 'a very clear ... creek or stream'").

We recognize that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines," *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992); but given the dissimilarities in appearance, sound, connotation and commercial impression, and the somewhat weak nature of the word SAND in connection with clothing, we find the marks are not confusingly similar when used on clothing.

#### 4. Balancing of the Factors

We have considered all of the evidence pertaining to the relevant *DuPont* factors, as well as the parties' arguments with respect thereto. In balancing the relevant factors, we find the differences between the marks sufficient to avoid likely confusion

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<sup>23</sup> Although described as "sheep" in the application, Ms. Guo refers to the design as a "stylized grassland goat." Guo Decl. ¶ 4, 24 TTABVUE 232.

despite the identical goods and trade channels, in particular given the differences in connotation and overall commercial impression, and the relative weakness of the shared word “sand” as used on clothing. “No mechanical rule determines likelihood of confusion, and each case requires weighing of the facts and circumstances of the particular mark.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010) (citing *Century 21 v. Century Life*, 23 USPQ2d at 1698)). Moreover, even absent the findings as to the weakness of the term “sand” in connection with clothing, the dissimilarities in the marks obviates likely confusion. *Kellogg Co. v. Pack'em Enters.*, 951 F.2d 330, 332-33, 21 USPQ2d 1142, 1144-45 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive”); *see also Champagne Louis Roederer v. Delicato Vineyards*, 47 USPQ2d at 1460, 61.

### **III. Conclusion**

Because Opposer has not shown, by a preponderance of the evidence, the existence of a likelihood of confusion, Opposer has not established its claim under Section 2(d).

**Decision:** The opposition is dismissed.